REMARKS

Claim Status

Claims 1-49 are pending in the application. This paper does not amend, cancel, or add claims. Claims 1, 27, 32, and 48 are the independent claims of the application.

Art Rejections

The Office Action rejected all claims of the application as follows:

1. Claims 1, 7, 8, 12-24, 26, 27, 29, 31, 48, and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel *et al.*, U.S. Patent Number 6,211,874 ("Himmel" hereinafter) in view of Gibson, U.S. Patent Number 6,313,854 ("Gibson" hereinafter);

2. Claims 2-5, 32-34, and 40-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and further in view of Kaply, U.S. Patent Number 6,215,490 ("Kaply" hereinafter);

3. Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Gilman *et al.*, U.S. Patent Number 6,208,770 ("Gilman" hereinafter);

4.   Claims 9-11 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and further in view of Iyengar *et al.*, U.S. Patent Number 6,360,205 ("Iyengar" hereinafter);

5.   Claims 25 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and further in view of what the Office Action asserted was admitted prior art;

6.   Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Gavron *et al.*, How to Use Microsoft Windows NT 4 Workstation 105 (Ziff-Davis Press, 1996) ("Gavron" hereinafter);

7.   Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Tang *et al.*, U.S. Patent Number 5,793,365 ("Tang" hereinafter);

8.   Claims 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Itoh, U.S. Patent Number 5,966,122 ("Itoh" hereinafter);

9.   Claim 44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Moore *et al.*, U.S. Patent Number 6,330,575 ("Moore" hereinafter);

10.   Claim 45 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Collins-Rector *et al.*, U.S. Patent Number 6,188,398 ("Collins-Rector" hereinafter);

11.   Claim 46 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of what the Office Action asserted was admitted prior art; and

12.   Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson, Kaply, what the Office Action asserted was admitted prior art, and further in view of Iyengar.

Applicant respectfully requests reconsideration and allowance of the claims based on the following arguments.

Art Rejections of Claims 1, 27, and 48

Declarations under Rule 1.131 Antedate Himmel

Applicant had previously submitted two declarations with attached exhibits under 37 C.F.R. § 1.131: (1) declaration dated December 18, 2003 ("First Rule 1.131 Declaration" hereinafter); and (2) supplemental declaration dated September 30, 2004 ("Second Rule 1.131 Declaration" hereinafter). Applicant argued that these two declarations establish that the invention as claimed in

independent claims 1 and 27 was reduced to practice before the effective date of the Himmel reference. The Office Action asserted (page 18) that "there is not explanation of the exhibits or positive statement on the declaration to support the limitation 'simultaneously displaying together in a *single window* the retrieved destination objects for viewing' in claims 1 and 27"

Note that Applicant's First Rule 1.131 Declaration explained, on page 3, exhibits 1-3 that were attached to it. Applicant's Second Rule 1.131 Declaration similarly explained, also on page 3, exhibits attached to it. Moreover, Reply to the previous Office Action quoted an entry dated September 30, 1996, from Exhibit 1 of the Second Rule 1.131 Declaration, and then explained how this entry established reduction to practice of the subject matter of claims 1 and 27. In particular, Applicant argued that Claims 1 and 27 substantially read on the embodiment ("demo") described in that entry. The embodiment included a means for displaying ("I was able to show the thumbnails," "display at once for comparison conveniences"). The embodiment also included means for selecting ("java scripted a primitive multi-select function, and submit function to fetch all data regarding the number of selected rug-thumbnails"). The embodiment further included means for retrieving ("fetch all data regarding the number of selected rug-thumbnails"). The displayed objects were linked to the destination objects ("I used some rug photographs to compose a catalog graphical thumbnails folder, a detailed graphics folder, and mock-up descriptions into another linked text folder, and mock up auction files for each rug"). The retrieved objects were displayed simultaneously together ("display at once for comparison conveniences").

With respect to the "single window" limitation, Exhibit 3 attached to the First Rule 1.131 Declaration shows a sample display format for the simultaneous display of all objects and related items stored for all of the selected items in a single window. To clarify this point further, a Second Supplemental Declaration Under 37 C.F.R. § 1.131 is being filed together with this Reply. In this Declaration, Applicant positively asserts that Exhibit 3 submitted with the "Declaration Under 37 C.F.R. § 1.131 dated December 18, 2003, shows a display within a single window."

The Office Action also asserted (pages 18-19) that the statement in the Second Rule 1.131 Declaration regarding reduction to practice on a single or local computer "raises the question where or not the Applicant had a conception before 1999." Initially, Applicant notes that reduction to practice generally follows conception, but conception need not be preceded by reduction to practice. Second, and more to the point, the claims in issue do not recite network-based apparatus or methods. Although the claims may read on networked systems and processes employing networks, the claims do not require such implementations. There is no requirement that the inventor actually reduce to practice all embodiments of the invention. As stated by the predecessor of the Court Appeals for the Federal Circuit,

> Rule 131 requires applicant to make oath to facts showing a completion "of the invention." That requirement does not mean affiant must show a reduction to practice of every embodiment of the invention. Nor is that requirement coextensive with the amount of disclosure necessary to support a claim under 35 U.S.C. 112.

In re Hostettler, 356 F.2d 562, 148 U.S.P.Q. 514, 516 (C.C.P.A. 1966).

The three Rule 1.131 Declarations filed in this case thus establish reduction to practice of the

subject matter of claims 1 and 27 prior to the effective date of the Himmel reference. The scope of claim 48 is similar to the scope of claim 1, and the Declarations similarly establish reduction to practice of the subject matter of claim 48 prior to the effective date of the Himmel reference. Applicant respectfully submits that claims 1, 27, and 48 are allowable over the references at least for this reason.

Gibson Reference Does Not Teach Claimed Display in Single Window

Applicant further notes that the references cited do not teach or suggest all elements of independent claims 1 and 27. Claim 1, for example, recites "means for retrieving . . . and then simultaneously displaying together in a single window the retrieved destination objects for viewing." The Office Action acknowledged (at page 3) that Himmel does not disclose the plurality of stored objects displayed within a single window. The Office Action then attempted to supplement this admitted deficiency of Himmel with the disclosure of Gibson. In particular, the Office Action asserted that "Gibson discloses a plurality of stored window objects 112a, 112b and 112c displayed within a single window 114," citing Gibson's figure 6 and column 8, lines 6-43.

Gibson's invention is intended for "displaying separate windows for respective frames, and enabling one or more window operations for each of the windows, such as resizing, minimizing, maximizing, and closing each of the windows." Gibson, the Abstract (emphasis provided). Describing Figure 6, which was cited in the Office Action, Gibson states that "FIG. 6 is a pictorial

representation of the creation of multiple child windows in a web browser wherein each child window corresponds to a respective frame defined by a web page." Gibson, col. 5, lines 45-48 (emphasis provided). Gibson teaches that "windowed frames can be displayed as child windows within a parent window on the display device, or in separate parent windows." Gibson, col. 4, line 66, through col. 5, line 1 (emphasis provided).

Gibson's text cited in the Office Action is to the same effect. For example, the cited text discloses that

> The page as it is intended to be displayed by the page creator (with three frames) is shown at the top of FIG. 6 in dashed lines. When the browser software retrieves page 110, it ascertains that the page is intended to be displayed with frames by interpreting the HTML tags, but it instead presents each frame as a separate window with its own controls to enable one or more window operations that otherwise would not be available to the frames.

Gibson, col. 8, lines 17-24 (emphasis added). Once again, Gibson teaches displaying in multiple windows.

Furthermore, it appears that Gibson's objects are not destination objects that are *dynamically linked to selected objects*, as are the objects displayed by the apparatus of claim 1 and the method of claim 27.

To make a *prima facie* case of obviousness, the references must teach or suggest all claim limitations. *E.g.*, MPEP § 2143. Because here the Himmel and Gibson references, individually or in combination, do not teach or suggest all of the limitations of claims 1 and 27, Applicant respectfully

submits that a *prima facie* case of obviousness has not been made.

Motivation to Combine Is Lacking

A *prima facie* case of obviousness also requires "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP § 2143. The suggestion must be found in the prior art, "not in applicant's disclosure." *Id.* Here , the purported motivation to combine Himmel and Gibson given in the Office Action (at page 3) is so that "users can more effectively manipulate and manage the viewable area of the browser while preserving the advantages of frames." The Office Action does not cite any specific prior art that teaches this motivation. If the statement in the Office Action means that the advantages of the apparatus and method of claims 1 and 27 would provide the requisite motivation, then the purported motivation was taken from Applicant's disclosure. But, as noted above, Applicants disclosure should not be used to make a *prima facie* case of obviousness. *E.g.*, MPEP § 2143; *In re Glaug*, 62 U.S.P.Q.2d 1151, 1155 (Fed. Cir. 2002) ("An inventor's explanation of how the invention works does not render obvious that which is otherwise unobvious."). If a different justification for the motive to combine is intended, than some reasoning in support of the rejection must be provided to support the *prima facie* case. "When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." MPEP § 2142 (citing *Ex parte Skinner*, 2

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U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986).

Himmel and Gibson fail to teach or suggest all the limitations recited in the independent claims 1, 27, and 48. Himmel and Gibson also fail to suggest the combination of the references to obtain the subject matter of independent claims 1, 27, and 48. At least for these reasons, Applicant respectfully submits that independent claims 1, 27, and 48 are allowable over Himmel and Gibson.

Claim 32

In rejecting independent claim 32, the Office Action acknowledged (at page 8) that "Himmel does not disclose the plurality of scrolling sub-framed arrays displayed within a single electronic webpage." The Office Action then sought to supplement Himmel with the teachings of Gibson and Kaply, asserting that "Gibson discloses a plurality of scrolling sub-framed arrays 112a, 112b and 112c displayed within a single electronic webpage 114 (fig. 6; col. 8, lines 6-43)."

Even if Gibson discloses a plurality of sub-frames within a webpage, Gibson's invention is intended for "displaying separate windows for respective frames, and enabling one or more window operations for each of the windows, such as resizing, minimizing, maximizing, and closing each of the windows." Gibson, the Abstract (emphasis provided). With respect to the very Figure 6 cited in the Final Office Action, Gibson states that "FIG. 6 is a pictorial representation of the creation of multiple child windows in a web browser wherein each child window corresponds to a respective

frame defined by a web page." Gibson, col. 5, lines 45-48 (emphasis provided). In fact, Gibson teaches that frames within a window may be undesirable:

> Frames are not child windows; that is, they are not resizable or otherwise controllable, since their attributes are fixed by the HTML coding. This aspect of frames can be very frustrating, because certain frames often take up so much of the web browser display area that other important frames are difficult to examine. . . .

> Older web browsers do not support frames, ...

Gibson, col. 4, lines 1-25.

Gibson thus <u>teaches away</u> from displaying multiple windows in sub-frames of a single window, as recited in independent claim 32. Instead, Gibson teaches that "windowed frames can be displayed as <u>child windows</u> within a parent window on the display device, or in <u>separate parent windows</u>." Gibson, col. 4, line 66, through col. 5, line 1 (emphasis provided). Not only the art of record fails to suggest a motivation do combine Gibson with Himmel and Kaply so as to obtain the subject matter of claim 32, but in fact the art teaches away from such combination.

At least for this reason, Applicant respectfully submits that independent claim 32 is allowable over Himmel, Gibson, and Kaply.

Dependent Claims

Dependent claims not specifically discussed should be patentable at least for the same reasons as their respective base claims and intervening claims, if any.
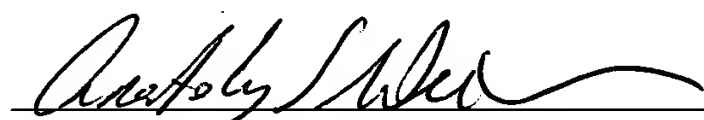
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CONCLUSION

For the foregoing reasons, Applicant respectfully submits that all pending claims are patentable. To discuss any matter pertaining to the present application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

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Anatoly S. Weiser, Reg. No. 43,229
12526 High Bluff Drive, Ste. 300
San Diego, CA 92130
(858) 720-9431